REMARKS/ARGUMENTS

In the Office action dated September 30, 2008, the examiner rejected claims 1-3, 5, 9-11, 13, 17, 22 and 30 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. In making this rejection, the examiner argues that although the probe body is described as generally rigid it is also described at page 5 of the specification as being malleable enough to be bent by a physician. See Office action, page 2. Presumably, the examiner argues that this disclosure in the specification renders the recitation of a generally rigid probe body indefinite. However, page 5 of the specification states, "*If desire[d]*, the tubular body 16 and/or the electrode 19 *can be heat-treated* so that they are malleable enough to be bent by a physician to a desired shape *but still rigid* enough that they will not bend in use during a procedure." (Emphasis added). The use of the phrase "if desired" in this sentence clearly denotes that the subsequent disclosure is optional, and therefore describes one alternative embodiment. In addition, in relying on this language to apparently assert that the probe body must be flexible, the examiner fails to appreciate that the tubular body only becomes malleable upon being heat-treated. As the present claims do not recite a heat-treated probe body, the recitation of a generally rigid probe body is definite, and is consistent with the disclosure in the specification.

The examiner also argues that "the inner and outer diameter ranges of the probe overlap, and therefore the wall of the probe may be so thin that it must be flexible." Office action, page 2. However, the specification clearly states that tubular body and/or the electrode are "rigid enough that they will not bend in use during a procedure." Specification, page 5, lines 12-14. As such, the values chosen for the inner and outer diameters of the tubular body and/or electrode must satisfy the requirement that the tubular body and/or electrode are rigid enough that they will not bend during a procedure. That the ranges of the inner and outer diameter overlap does not negate the requirement in the claims that the probe body is generally rigid. Indeed, if the inner diameter of the tubular body is chosen as 0.4 inches (the low end of the inner diameter range) and the outer diameter is chosen as 0.9 inches (the high end of the outer diameter range), the tubular

body would have a thickness of 0.5 inches, which would provide a generally rigid tubular body. As such, applicant submits that claims 1-3, 5, 9-11, 13, 17, 22 and 30 are definite.

The Examiner also rejected claims 1-30 under 35 U.S.C. §103(a) as allegedly obvious over Pomeranz, et al. (U.S. Patent No. 5,800,482) in view of Swanson, et al. (U.S. Patent No. 6,428,537). In making this rejection, the Examiner admits that Pomeranz fails to disclose the generally rigid probe body recited in the claims, but relies on Swanson to remedy this deficiency. In particular, the Examiner argues that "Swanson teaches that it is known to use catheter-based devices with surgical probes that are not catheter-based as probes [to] allow the physician to directly apply the electrode to the tissue." Office action, page 3 (citing Swanson at column 24, lines 20-25). However, Swanson nowhere teaches or suggests a *generally rigid* probe body as presently claimed. In addition, Swanson does not inherently disclose a generally rigid probe body because the probe body discussed in Swanson is not *necessarily* generally rigid. *See In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999)(stating that to establish inherency, the missing descriptive matter must be "necessarily present in the thing described in the reference")(quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991))("*Robertson*"). Indeed, Figure 23 of Swanson (described as an example of a surgical device (or "probe")) appears to illustrates a flexible body connecting component 228 and 229. Swanson therefore also fails to teach or suggest a generally rigid probe body as recited in independent claims 1, 5, 17 and 22. Accordingly, independent claims 1, 5, 17 and 22, and all claims dependent therefrom, including claims 2-4, 6-16, 18-21 and 23-30, are allowable over Pomeranz and Swanson.

Claims 1-30 remain pending in this application. In light of the above remarks, applicant submits that all of pending claims 1-30 are in condition for allowance. Applicant therefore respectfully requests reconsideration and a timely indication of allowance. However, if there are

any remaining issues that can be addressed by telephone, applicant invites the examiner to contact applicant's counsel at the number indicated below.

Respectfully submitted,

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